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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,977	04/18/2001	Joel M. Rosenberg	INTL-0557-US (P11215)	9072
7590	04/20/2005		EXAMINER	
Timothy N. Trop TROP, PRUNER & HU, P.C. STE 100 8554 KATY FWY HOUSTON, TX 77024-1805			COLLINS, DOLORES R	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 04/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/836,977	ROSENBERG, JOEL M.
	<b>Examiner</b>	<b>Art Unit</b>
	Dolores R. Collins	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 January 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1,3-12,14-18,20 and 21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,3-12,14-18,20 and 21 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3, 4 & 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hino et al. (036).

Hino discloses a Water Tank For Wireless Remote-Controlled Underwater Toys.

#### Regarding claims 1 & 10-11

Hino teaches a controller which controls a plurality of elements and positions a toy in three dimensions without physical contact (col. 3, lines 19-49).

#### Regarding claim 3

Hino teaches the use of a three dimensional structure (see figure 1).

Regarding claim 4

Hino teaches a surface which includes a matrix of elements in the form of an emitter (2).

2. Claims 12, 16-18 & 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Castillo et al. (454).

Castillo discloses a System and Method For Detecting a Relative Change In Light Intensity.

Regarding claims 12 & 16-17

Castillo teaches receiving a command and reaction of a toy in response to the command (see abstract & figure 1).

Regarding claims 18 & 20-21

Castillo teaches a system that comprises a medium storing instructions that enable a processor-based system. Castillo further teaches receiving a command and reaction of a toy in response to the command (see abstract & figure 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hino et al. (036).

Hino discloses a Water Tank For Wireless Remote-Controlled Underwater Toys.

Regarding claim 5

Hino teaches the use of a three dimensional structure in the form of a rectangle, having at least four walls (see figure 1). Although Hino teaches electrically controllable elements in one wall (see col. 3, lines 19-23), he fails to teach that each of his walls include this feature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate the teaching of electrically controllable elements in walls, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Regarding claims 6-7

Hino teaches a fluid filled box in the form of a water tank (see figure 1).

4. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hino et al. (036) as applied to claim 1 and further in view of Horiuchi (096).

Hino discloses a Water Tank For Wireless Remote-Controlled Underwater Toys.

Regarding claim 8

Hino fails to explicitly teach a permanent magnet in his toy/playing piece.

Horiuchi discloses a Swimming Toy Fish Aquarium Having magnetic Drive System For Magnetically Driving The toy Fish In The Aquarium. Horiuchi teaches that his toy contains a magnet (see abstract & figure 3 (6)). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the toy/play piece of Hino to include a magnet for increased stability.

Regarding claim 9

Hino teaches that his toy is buoyant (see col.3, lines 33-36 & col. 3, lines 65-66 & col. 4, lines 1-7).

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castillo et al. (454) in view of Hino et al. (036).

Castillo discloses a System and Method For Detecting a Relative Change In Light Intensity.

Regarding claim 14

Castillo fails to explicitly teach applying current to selected electromagnets in a matrix of electromagnets. Hino discloses a Water Tank For Wireless Remote-Controlled Underwater Toys. Hino teaches elements that are electromagnetic (see abstract & col.3, lines 50-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Castillo to include the use of electromagnets as taught by Hino for better control of the toy.

Regarding claim 15

Castillo fails to teach a play piece being moved in a liquid environment. Hino discloses a Water Tank For Wireless Remote-Controlled Underwater Toys. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a liquid environment for Castillo's toy to add flexibility for its' use.

***Response to Arguments***

Applicant's arguments filed 1/18/05 have been fully considered but they are not persuasive. Applicant has amended claims 1, 5, 12 & 18 to include the use of electromagnets. Applicant further argues that Hino only transmits electromagnetic waves. Hino teaches elements that are electromagnetic (see abstract & col.3, lines 50-56). Elements capable of receiving electromagnetic waves in order to respond are themselves electro magnetically based. Examiner maintains the rejection of the first office action.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited to show the state of art with respect to features of the claimed invention.

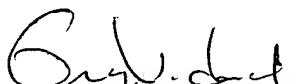
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Dolores R. Collins** whose telephone number is (703) 308-8352. The examiner can normally be reached on 8.00 A.M. - 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Greg Vidovich** can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



April 15, 2005

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700